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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/743,745	12/24/2003	Shigekazu Yasuoka	SNY-048	9090

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EXAMINER	
ALEXANDER, MICHAEL P	
ART UNIT	**PAPER NUMBER**
1742	

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/743,745	YASUOKA ET AL.	
	Examiner	Art Unit	
	Michael P. Alexander	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-25 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 05/04/2004.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim(s) 1-25 is/are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 7, 13, 15, 17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kohno (US 6,130,006).

Regarding claims 1, 3, 5, 7, 13, 15, 17 and 19, Kohno teaches (see cols. 58-59 and Example 137 in Table 16) an alkaline storage batter comprising a positive electrode, a negative electrode and an alkaline electrolyte, wherein the negative electrode comprises hydrogen absorbing alloy satisfying the claimed formula, further containing Zr and Mn.

Claims 1, 3, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Ryuko (JP 2000-265229).

Regarding claim 1, 3, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23 and 25, Ryuko teaches (see second Example 1 in Table 1 and Example 7 in Table 2, paragraphs 0009, 0013, 0099, 0119-0121) an alkaline storage battery comprising a positive electrode, a negative electrode and an alkaline electrolyte, wherein the negative electrode comprises a hydrogen-absorbing alloy having an alloy composition satisfying the claimed compositional formula, further containing Zr, Mn, Cu and Cr, ground to 100

micrometers or less, wherein the amount of alkaline electrolyte would be 0.30 ml per 1g of the hydrogen absorbing alloy (i.e. 2.4 ml / 8 g).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 4, 6, 8, 10, 12, 14, 16, 18, 20, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryuko (JP 2000-265229).

Regarding claim 1, 3, 5, 7, 9, 11, 13, 15, 17, 19, 21, 23 and 25, Ryuko teaches (see abstract, paragraphs 0009, 0013, 0099, 0119-0121) an alkaline storage battery comprising a positive electrode, a negative electrode and an alkaline electrolyte, wherein the negative electrode comprises a hydrogen-absorbing alloy having an alloy composition overlapping with the claimed compositional formula, further containing Y, Zr, Mn, Cu and Cr, ground to 100 micrometers or less, wherein the amount of alkaline electrolyte would be 0.30 ml per 1g of the hydrogen absorbing alloy (2.4 ml / 8 g). The

overlapping ranges is prima facie evidence of obviousness. See MPEP 2144.05 I. It would have been obvious to one ordinary skill in the art to select the desired amounts of each the claimed elements from the amounts disclosed by Ryuko because Ryuko teaches the same utility throughout the claimed ranges.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3, 5, 13, 15 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 11/356448. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 3 of the copending application teaches all the limitations and the alloy composition overlaps with that of the claimed invention, which is prima facie evidence of obviousness. See MPEP 2144.05 I.

It would have been obvious to one of ordinary skill in the art to select the desired amounts of the claimed elements from the ranges of copending claim 3 because the copending application teaches the same utility throughout the disclosed ranges.

Claims 1, 3, 5, 13, 15 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 11/348261. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of the copending application teaches all the limitations and the alloy composition overlaps with that of the claimed invention, which is prima facie evidence of obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to select the desired amounts of the claimed elements from the ranges of copending claim 2 because the copending application teaches the same utility throughout the disclosed ranges.

Claims 1 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 11/169901. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 of the copending application teaches all the limitations and the alloy composition overlaps with that of the claimed invention, which is prima facie evidence of obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to select the desired amounts of the claimed elements from the ranges of copending claim 9 because the copending application teaches the same utility throughout the disclosed ranges.

Claims 1 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-14 of copending Application No. 11/041678. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 13-14 of the copending application teaches all the limitations and the alloy composition overlaps with that of the claimed invention, which is prima facie evidence of obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to select the desired amounts of the claimed elements from the ranges of copending claims 13-14 because the copending application teaches the same utility throughout the disclosed ranges.

Claims 1 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/787593. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of the copending application teaches all the limitations and the alloy composition overlaps with that of the claimed invention, which is prima facie evidence of obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to select the desired amounts of the claimed elements from the ranges of copending claim 2 because the copending application teaches the same utility throughout the disclosed ranges.

Claims 1, 5, 13 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/758541. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the copending application

teaches all the limitations and the alloy composition overlaps with that of the claimed invention, which is prima facie evidence of obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to select the desired amounts of the claimed elements from the ranges of copending claim 1 because the copending application teaches the same utility throughout the disclosed ranges.

These are provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Alexander whose telephone number is 571-272-8558. The examiner can normally be reached on M-F 10:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V. King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

mpa

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